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09/436,796	11/08/1999	STEVEN R. DONOVAN	RIC99060	7148

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EXAMINER

LOGSDON, JOSEPH B

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/436,796
Filing Date: November 08, 1999
Appellant(s): DONOVAN ET AL.

George S. Blasiak
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 April 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect because only the rejections of claims 1-28 under 35 U.S.C. 112, first paragraph for lack of adequate written description remain.

(4) Status of Amendments After Final

The appellant's statement that no amendments after final rejection were filed contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The rejections of claims 1-28 for lack of enablement and the rejections of claims 1-22 under 35 U.S.C. 103(a) are withdrawn. Only the rejection of claims 1-28 under 35 U.S.C. 112, first paragraph, for lack of enablement, remains.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims stand or fall together is not agreed with because claims 1-28 all stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 16, and 19 specify that the call setup request, which originates from the SUA, identifies the DUA. The specification states, "The SIP INVITE is addressed to the called party DUA 103 at a proxy address at the SPS 106" (page 12). This statement is consistent with the well-known method of IP addressing in which e-mail addresses are used. The specification goes on to state, "The SIP INVITE specifies the real IP address of the DUA 103" (page 12). As discussed in Schulzrinne, section 4, for example, the INVITE message would thus be of the form user@IP address. Both the user and the IP address are specified, but the DUA is not. The specification fails to describe this modification to conventional SIP, i.e., the specification fails to describe the *identification* of the DUA. Claims 2-15, 17, 18, and 20-28 depend on claims 1, 16, and 19 and are therefore similarly rejected.

(11) Response to Argument

In arguing that the specification has adequate written description for the claims, Appellant points to page 12 of the specification, which says, "The SIP INVITE is addressed to the called party DUA 103 at a proxy address at the SPS 106. The SIP INVITE specifies the real

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IP address of the DUA 103.” Apparently, Appellant believes these sentences mean the same thing as, “the call setup request identifies the destination user agent,” as recited in the claims.

It would, however, have been clear to one skilled in the art that the former does not mean the same thing as the latter. The first sentence is simply consistent with the reference to Schulzrinne, which was used in the Office Actions. As depicted in Fig. 3 of Schulzrinne, the proxy address is henning@cs.columbia.edu. This identifies the user “henning,” not the DUA “play.” Only the proxy server in Fig. 3 identifies the DUA “play.” The first sentence is therefore not the same thing as, “the call setup request identifies the destination user agent.”

Appellant apparently believes that specification of the IP address of the DUA means the same thing as identification of the DUA. But, as would have been obvious to anyone skilled in the art, this is simply not true. Consider, for example, the U.S. Patent No. 6,266,335 to Bhaskaran, which teaches a cluster of IP servers—each of which has the same IP address (see Fig. 2 and the abstract). The network flow switch 205, in Fig. 2, identifies the servers using their unique MAC addresses (column 7, lines 43-46). This patent is only one example of many patents that teach the same principle: a group of devices, of any kind (including DUAs), can share a common IP address. Another well known principle is the following: a user can travel from one DUA to another, while maintaining the same IP address; therefore, each DUA can change its IP address, while the user maintains the same IP address. Therefore, the specification of an IP address of a device does not necessarily identify that device. It is for this reason that the claims lack written description.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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Wednesday, June 05, 2002
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